

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed September 17, 2004. At the time of the Final Office Action, Claims 1-3, 6-10, 13, and 16-21 were pending in the Application. Applicant amends Independent Claims 1, 6, and 13 in order to advance prosecution in this case. The amendments to the claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments are without prejudice or disclaimer. Applicant also adds new Claims 22, 23, and 24. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-3, 13, and 16-21 under 35 U.S.C. §103(a), as being unpatentable over European Patent Application EP 920153 A2 (hereinafter "*Shiragaki*") in view of U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereinafter "*Cadeddu*") and in view of an article entitled "Optical restoration at the wavelength-multiplex-section level in WDM mesh networks" (hereinafter "*Karasan*").

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142-43.) It is respectfully submitted that these claims are patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

Independent Claims 1, 6, and 13 generally recite a configuration of transponders that are operable to facilitate the operations of the system. Neither *Cadeddu*, nor *Karasan*, nor *Shiragaki* offer such an arrangement. Moreover, the structure of *Cadeddu*, *Karasan*, and *Shiragaki* are incapable of performing the operations, as identified by Independent Claims 1, 6, and 13. Note that because the reconfiguration takes places at the channel level, each node does not have to be provided with switching equipment to perform protection on all the network channels. (See

Original Specification for support: pages 5-6.) For at least these reasons, these Independent Claims are patentable over these references.

Applicant also notes that any combination of *Shiragaki*, *Karasan*, and *Cadeddu* and some other reference that may disclose a channel level operation would be inappropriate in the context of the §103 rejection. This is because there is no evidence to suggest that *Shiragaki*, *Karasan*, and/or *Cadeddu* would be capable of successfully operating in a fashion outlined by the Examiner. In addition, there is no evidence to support that any of these references could provide the transponder configuration identified by pending subject matter. Moreover, there is no teaching, disclosure, or suggestion to make any such combinations proffered by the Examiner. These essential facts would vitiate another prong of obviousness and, therefore, render the pending claims allowable based on this single reason.

Thus, Independent Claims 1, 6, and 13 are allowable over *Cadeddu*, *Karasan*, and *Shiragaki* for the reasons tendered above. In addition, the dependent claims associated with these Independent Claims are also allowable for analogous reasons. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

Double Patenting Rejection

Claims 1-3, 6-10, and 16-21 of the present application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39 and 43 of co-pending Application 09/750,311 in view of *Shiragaki* and *Karasan*. Applicant stands prepared to submit a Terminal Disclaimer in order to overcome the nonstatutory double patenting rejection. Any filing of the Terminal Disclaimer should not be construed as an agreement with or an acquiescence to the propriety thereof. Applicant reserves the right to comment on the appropriateness of the Terminal Disclaimer at a future time, should Applicant deem it appropriate to do so.

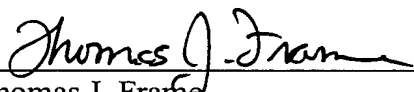
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame at (214) 953-6675.

Respectfully submitted,
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